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b) adhering the device to a substrate by adhering a free side of the adhesive sheet to said substrate; and

c) releasing the device from the substrate by pulling on the grip tab on the adhesive sheet in a direction of a plane of a bond formed between the adhesive sheet and the substrate.

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CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Claim 1-18 have been canceled and recast as new claims 19-44 for clarity. A clean copy of these claims is presented above. The table below shows the old claim and the corresponding new claim. It is

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believed that no new matter has been added.

| New Claim | Old Claim |
|-----------|-----------|
| 19        | 1         |
| 20        | 2         |
| 21        | 2         |
| 22        | 3         |
| 23        | 4         |
| 24        | 5         |
| 25        | 5         |
| 26        | 6         |
| 27        | 6         |
| 28        | 7         |
| 29        | 8         |
| 30        | 9         |
| 31        | 9         |
| 32        | 10        |
| 33        | 10        |
| 34        | 11        |
| 35        | 12        |

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|    |    |
|----|----|
| 36 | 13 |
| 37 | 13 |
| 38 | 14 |
| 39 | 15 |
| 40 | 16 |
| 41 | 16 |
| 42 | 17 |
| 43 | 17 |
| 44 | 18 |

Rejections under 35 U.S.C. 102(e) and 35 U.S.C. 103(a)

Claims 1 and 11-18 stand rejected under 35 U.S.C 102(e) as being anticipated by Luhmann (U.S. Patent No. 6,136,397). According to the Examiner, Luhmann teaches a redetachable self-adhesive device comprising a plate whose reverse surface is bonded with a double-sided adhesive sheet having an outwardly projecting grip tab.

The Examiner rejected claims 1-4 and 6-8 under 35 U.S.C. 103(a) as being obvious in view of Luhmann. Luhmann is discussed above. The Examiner found it would have been obvious to provide a spacing distance as claimed in the edge region by optimization using an optimum sized roller.

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In response to the 102(e) rejection, Applicants would remind the Examiner that "[a] claim is anticipated only [if] each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); See MPEP § 2131. Applicants submit there is no teaching in the reference therein of a distance V between at least one end of the device and the adhesive sheet as claimed. The reference shows a configuration, wherein the roller and the plate are not offset from the adhesive tape, but rather, are in direct contact with the adhesive tape. The main claim has now been amended to make this distance V clear, wherein "the device, on at least one end thereof, not abutting the adhesive sheet, but being offset therefrom a distance V". Accordingly, since Luhmann does not teach a device, "on at least one end thereof, not abutting the adhesive sheet, but being offset therefrom a distance V", the claims are not anticipated.

Regarding the obviousness rejection, there is no suggestion or motivation to obtain the present invention because the reference does not contemplate a distance V between the device and the adhesive sheet as claimed, nor, therefore, would it have been obvious to optimize this variable. It would appear the Examiner is focusing on the rotatable roller embodiment of Luhmann. In Luhmann, the roller and the plate are in direct contact with the adhesive tape, and, therefore, the roller and the plate abut the adhesive tape on both ends of the device, and is not offset therefrom. In this regard, Applicants point out that the roller is a part of the device, and in the rotatable roller embodiment of Luhmann, the rollers contact the adhesive

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tape. Therefore, the rotatable roller embodiment does not inherently meet the limitations of the present claims, wherein the device, "on at least one end thereof, [does not abut] the adhesive sheet, but [is] offset therefrom a distance V."

Furthermore, Applicants point to Example A in the specification, wherein the table at the top of page 10 lists tear frequency results when using a plate at a distance V. The first plate, for which there is no offset distance, resulted in the worst tear frequency at 63%. Subsequent plates where there is a distance between at least one end of the device and the adhesive sheet resulted in tear frequencies at least 90% less than when plates with no offset distance are used. Applicants submit the significant difference in tear frequencies is evidence of unexpected and/or surprising results, and thus evidence of nonobviousness. See e.g., *In re Chupp*, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987) ("Evidence that a compound is unexpectedly superior in one of a spectrum of common properties, as here, can be enough to rebut a prima facie case of obviousness.") Accordingly, not only is there is no suggestion or motivation to make and use a device including on at least one end the claimed offset distance, but the data in the specification show that an offset distance on at least one end of the device renders unexpected benefits. Respectfully, Applicants submit that the claims are not rendered obvious. Although these data are not in declaration form, consistent with the rule that all evidence of nonobviousness must be considered when assessing patentability, the Examiner must consider data in the specification in determining whether the claimed invention provides unexpected results. *In re Soni*, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

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On the issue of optimization, Applicants would add that Luhmann does not teach or suggest anywhere that an offset distance on at least one end of the device is a result-effective variable affecting results. Accordingly, as a matter of law, a person having ordinary skill in the art would not have found it obvious to optimize this parameter. The general rule established in *In re Aller*, 105 USPQ 233 (CCPA 1955), is that the discovery of an optimum value of a variable in a known process is normally obvious. However, the court in *In re Antonie*, 195 USPQ 6, 8-9 (CCPA 1977), recognized an important exception to this general rule—where the variable optimized by applicant was not known in the prior art to be a "result-effective" variable, a person skilled in the art would not have found it obvious to optimize that variable. Since the cited prior art does not teach or suggest that an offset distance on one end of the device is a result-effective variable affecting the tearing problem, in view of *Antonie*, a person having ordinary skill in the art would not have found it obvious to optimize it.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw these rejections. An early notice that these rejections have been reconsidered and withdrawn is, therefore, earnestly solicited.

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Rejection under 35 U.S.C. 112, second paragraph

The Examiner rejected claims 1-18 under 35 U.S.C 112, second paragraph as being indefinite. In response, Applicants submit the claims have been amended to overcome the Examiner's concerns found at pages 3-4 of the Office Action. In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

For the record, Applicants emphasize that although the claims were amended to overcome this rejection, and, therefore, might be considered to have been amended for a reason substantially related to patentability, a fair reading of the amended claims will reveal that the departures from the previous claims were for clarification purposes only, and that Applicants did not narrow the claims in any material respect. Therefore, Applicants submit that the amended claims are entitled to the full range of equivalents.

Conclusion

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for Immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

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Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By 

David D. Kim  
Reg. No. 53,123

220 East 42<sup>nd</sup> Street  
30<sup>th</sup> Floor  
New York, New York 10017  
(212) 808-0700

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 (13 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: March 7, 2003

By 

David D. Kim